



IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Serial No. : 09/836,705

Applicants : Yuki ABE et al.

Filed : April 17, 2001

Art Unit : 1652

Examiner : Kathleen M. Kerr

Docket No. : 01149/HG

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PETITION UNDER 37 CFR 1.144

S I R :

This is a Petition from the Requirement for Restriction set forth in the Office Action of February 19, 2003 (Paper No. 13), which Restriction Requirement was made final in the Office Action of May 29, 2003 (Paper No. 15). Applicants requested reconsideration of the Restriction Requirement in their RESPONSE TO RESTRICTION REQUIREMENT filed March 12, 2003.

A. Background

Restriction was required under 35 USC 121 in the February 19, 2003 Office Action as follows:

Group I. Claims 1-4, 8-10, 13-17, 23-34 and 54, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOS: 37/38;

Group II. Claims 1, 5-8, 11, 12, 18-34 and 55, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOs: 41/42;

Group III. Claims 35-37, drawn to polypeptides relating to SEQ ID NO: 38;

Group IV. Claims 35, 38 and 39, drawn to polypeptides relating to SEQ ID NO: 42;

Group V: Claims 40-43 and 45, drawn to methods of producing ML-236B or Pravastatin using SEQ ID NO: 37;

Group VI: Claims 40-43 and 45, drawn to methods of producing ML-236B or Pravastatin using SEQ ID NO: 41;

Group VII: Claim 44, drawn to the ML-236B compound;

Group VIII: Claim 46, drawn to antibodies to SEQ ID NO; 38;

Group IX: Claim 46, drawn to antibodies to SEQ ID NO: 42;

Group X: Claims 47-51, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOs: 43/44;

Group XI: Claims 47-51, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOs: 45/46;

Group XII: Claims 47-51, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOs: 47/48;

Group XIII: Claims 47-51, drawn to polynucleotides, vectors and host cells relating to SEQ ID NOs: 49/50;

Group XIV: Claim 52, drawn to polypeptides relating to SEQ ID NO: 44;

Group XV: Claim 52, drawn to polypeptides relating to
SEQ ID NO: 46;

Group XVI: Claim 52, drawn to polypeptides relating to
SEQ ID NO: 48;

Group XVII: Claim 52, drawn to polypeptides relating to
SEQ ID NO: 50;

Group XVIII. Claim 53, drawn to methods of producing
ML-236B using SEQ ID NOS: 43/44;

Group XIX: Claim 53, drawn to methods of producing
ML-236B using SEQ ID NOS: 45/46;

Group XX: Claim 53, drawn to methods of producing
ML-236B using SEQ ID NOS: 47/48; and

Group XXI: Claim 53, drawn to methods of producing
ML-236B using SEQ ID NOS: 49/50.

In reply to the Restriction Requirement, applicants elected Group VI (claims 40 to 43 and 45) drawn to methods of producing ML-236B or Pravastatin using SEQ ID NO: 41.

B. Request for Modification of the Restriction Requirement

1. Groups I to III, V to VII and X to XXI were all classified by the Examiner in Class 435 in the February 19, 2003 Office Action.

Groups IV, VII and IX were all classified by the Examiner in Class 530 in the February 19, 2003 Office Action.

Accordingly, it is respectfully requested that the 21 Groups be reduced to two Groups, namely one Group directed to the 18 Groups (I to III, V to VII and X to XXI) classified in Class 435 and a second Group directed to the 3 Groups (IV, VIII and IX) classified in Class 530.

2. If the above request that the present 21 Groups be reduced to the above-identified two Groups is not accepted, then it is requested that the present Restriction Requirement be modified to no more than four Groups, as follows.

Group A: Groups I, II and X to XIII (which the February 19, 2003 Office Action referred to as the "DNA Groups") that were identically classified in Class 435, Subclass 252.3 in the February 19, 2003 Office Action;

Group B: Groups V to VII and XVII to XXI that were identically classified in Class 435, Subclass 156 in the February 19, 2003 Office Action (which include Groups V, VI and XVIII to XXI which said February 19, 2003 Office Action referred to as the "Method Groups");

Group C: Groups VIII and IX (which the February 19, 2003 Office Action referred to as the "Antibody Groups") that were identically classified in Class 530, Subclass 387.1 in the February 19, 2003 Office Action.

Group D: Groups III, IV and XIV to XVII (which the February 19, 2003 Office Action referred to as the "Polypeptide Groups") which include Groups XIV and XV that were identically classified in Class 435, Subclass 183 in said February 19, 2003 Office Action and also include Groups XVI and XVII that were identically classified in Class 435, Subclass 190 in the February 19, 2003 Office Action.

3. Modification of the Restriction Requirement is also respectfully requested because several Groups as indicated hereinabove are directed to the same claim or claims (see MPEP 803.02 entitled "Restriction-Markush Claims").

Groups V and VI are both directed to claims 40-43 and 45.

Groups VIII and IX are both directed to claim 46.

Groups X to XIII are all directed to claims 47 to 51.

Groups XIV to XVII are both directed to claim 52.

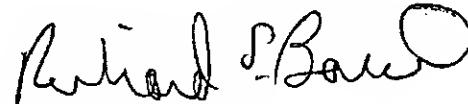
Groups XVIII to XXI are all directed to claim 53.

It was noted at the top of page 3 of the May 29, 2003 Office Action that there is a commonality with respect to the two genes in that they are both polynucleotides from the same source species and that their encoded proteins are involved in ML-236B biosynthesis.

It is therefore respectfully requested that the Restriction Requirement be modified as discussed above.

No fee is considered to be required for this Petition. However, if a fee is required, please charge such fee to Deposit Account No. 06-1378.

Respectfully submitted,



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